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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,628	11/21/2003	Masami Enda	245768US0TTC	8627
22850	7590	08/10/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				HERTZOG, ARDITH E
ART UNIT		PAPER NUMBER		
				1754

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/717,628	ENDA ET AL.
Examiner	Art Unit	
Ardith E. Hertzog	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 21 November 2003.  
2a)  This action is FINAL.                  2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-11 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) 1-11 are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
    1.  Certified copies of the priority documents have been received.  
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

**Group I:** Claims 1-8, drawn to a "method for chemically decontaminating radioactive material", classified in class 588, subclass 313+.

**Group II:** Claim 9, drawn to a "system for chemically decontaminating radioactive material which forms a passage for liquid to flow through", classified in class 422, subclass various.

**Group III:** Claims 10-11, drawn to a "system for chemically decontaminating radioactive material", classified in class 422, subclass various.

2. The inventions are distinct, each from the other, because of the following reasons:

a. The inventions of **Group I** and **Group II** are related as process and apparatus (system) for its practice. The inventions are distinct if it can be shown that **either**: (1) the process as claimed can be practiced by another materially different apparatus or by hand, **or** (2) the apparatus as claimed can be used to practice another and materially different process (see MPEP § 806.05(e)). In this case, the process (method) as claimed can be practiced by another materially different apparatus, as evinced by claim 1, wherein no apparatus (system) is required.

- b. The inventions of **Group I** and **Group III** are related as process and apparatus (system) for its practice. The inventions are distinct if it can be shown that **either**: (1) the process as claimed can be practiced by another materially different apparatus or by hand, **or** (2) the apparatus as claimed can be used to practice another and materially different process (see MPEP § 806.05(e)). In this case, the process (method) as claimed can be practiced by another materially different apparatus (system), as evinced by claim 1, wherein no apparatus is required.
- c. The inventions of **Group II** and **Group III** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) the subcombination has utility by itself or in other combinations (see MPEP § 806.05(c)). In this case, the combination as claimed does not require the particulars of the subcombination as claimed, because claim 9 does not require: i) "a decontamination tank for containing radioactive material and decontamination liquid", nor ii) "a direct current power source for providing potential difference between the radioactive material and an anode", as required by claim 10. The subcombination has separate utility, such as by itself, i.e., apparatus (systems), per claim 10.

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3. Because these inventions are distinct for the reasons given above and, with respect to **Group I** and **Groups II and III**, have acquired a separate status in the art as shown by their different classification, **and**, with respect to **Group II** and **Group III**, the search required for **Group III** is not required for **Group II**, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (see 37 CFR § 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

### *Conclusion*

6. Any inquiry concerning this communication should be directed to Ardit E. Hertzog at 571-272-1347. The examiner can normally be reached on Monday through Friday (from about 8:00 a.m. - 4:00 p.m.).

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman, can be reached at 571-272-1358. The central fax number for all communications is now 571-273-8300.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. For any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
AEH  
August 1, 2005

  
STANLEY S. SILVERMAN  
SUPERVISORY PATENT EXAMINER  
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